

Commissioner for Patents  
 June 20, 2005  
 Page 9 of 12

Serial No. 10/606,973  
 Art Unit: 1771 Examiner: Ms. Arti Singh  
 Atty Docket: AMG.4016.PAT

REMARKS

Claims 1-3 are pending and claims 1-3 stand rejected. In particular, the Office action rejects claims 1-3 under 35 USC § 102(b) as being anticipated by Powers U.S. Pat. 4,438,178 (hereinafter "Powers") and rejects claims 1-3 under 35 USC § 102(e) as being anticipated by Fisher U.S. Pat. App. 2002/0122938 (hereinafter "Fisher"). Applicant respectfully submits that the cited references are directed toward the tire industry and specifically for adhering threads to the rubber compounds of tires, which is non-analogous to the textile and garment industry.

Applicant requests that claims 1-3 be amended and new claims 4-22 be added as indicated above. However, the amendments to claims 1-3 are intended to clarify/emphasize the meaning of the claims.

Claim rejections under 35 USC § 102

Claims 1-3 stand rejected under 35 USC § 102(b) as being anticipated by Powers. Applicant respectfully suggests that the rejections with respect to amended independent claim 1 are traversed in the following remarks.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference.<sup>1</sup> Furthermore, the identical invention must be shown in as complete detail as is contained in the claim.<sup>2</sup>

**POWERS**

With regards to the amended independent claim 1, the Office action fails to establish a *prima facie* case of anticipation by Powers because citations of Powers provided as support for the rejections fail to describe, suggest or teach "each and every element as set forth in the claim[s]". In particular, amended claim 1 states:

... A sewing thread consisting of a thread coated in a thermally activated adhesive, where the adhesive is active when heated and set when cooled, *the sewing thread being wrapped around a spool, wherein the spool is adapted for use with a sewing machine for textiles.*-(emphasis added).

Although Powers teaches:

<sup>1</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Commissioner for Patents  
 June 20, 2005  
 Page 10 of 12

Serial No. 10/606,973  
 Art Unit: 1771 Examiner: Ms. Arti Singh  
 Atty Docket: AMG.4016.PAT

Adhesive activated fibers of the invention can obtain *a degree of adherence to rubber* equal to or closely approaching adherence provided by epoxy adhesive activated polyester fibers. (Abstract, emphasis added).

Polyester fibers, cords and fabrics are used extensively for reinforcing rubber articles such as tires, belts, hoes and the like.-(col. 1, lines 10-12).

Powers does not describe, teach or suggest, expressly or inherently, the elements of currently amended independent claim 1. In particular, Powers' disclosure of coated polyester fibers to adhere the fibers to rubber does not describe, teach or suggest, expressly or inherently, "the sewing thread being wrapped around a spool, wherein the spool is adapted for use with a sewing machine for textiles." Thus, Applicant respectfully requests that the rejection of claim 1 be withdrawn and that claim 1 be allowed.

Furthermore, claims 2-4, being dependent upon claim 1, incorporate the limitations of amended claim 1. Thus, Powers does not describe, teach or suggest, expressly or inherently, all the limitations of dependent claims 2 and 3 so Applicant respectfully requests that these rejections be withdrawn and claims 2-4 be allowed.

Powers also fails to anticipate all the elements of the new independent claims 5, 11, 15, and 19. Particularly, Powers' disclosure of coated polyester fibers to adhere the fibers to rubber does not describe, teach or suggest, expressly or inherently, the limitations of the new independent claims 5, 11, 15, and 19.

Furthermore, claims 6-10, 12-14, 16-18, and 20-22, incorporate the limitations of the corresponding new independent claims. Thus, Powers does not describe, teach or suggest, expressly or inherently, all the limitations of these dependent claims so Applicant respectfully requests that these claims be allowed.

### **FISHER**

With regards to the amended independent claim 1, the Office action fails to establish a *prima facie* case of anticipation by Fisher because citations of Fisher provided as support for the rejections fail to describe, suggest or teach "each and every element as set forth in the claim[s]".

Fisher teaches:

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<sup>2</sup> *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

*Commissioner for Patents*  
June 20, 2005  
Page 11 of 12

Serial No. 10/606,973  
Art Unit: 1771 Examiner: Ms. Arti Singh  
Atty Docket: AMG.4016.PAT

The coating adheres the polyester cords to the rubber to yield good peel strength results and good visual coverage ratings.-(Abstract, emphasis added).

Fisher does not describe, teach or suggest, expressly or inherently, the elements of currently amended independent claim 1. In particular, Fishers' disclosure of coated polyester cords to adhere the cords to rubber does not describe, teach or suggest, expressly or inherently, "the sewing thread being wrapped around a spool, wherein the spool is adapted for use with a sewing machine for textiles." Thus, Applicant respectfully requests that the rejection of claim 1 be withdrawn and that claim 1 be allowed.

Furthermore, claims 2-4, being dependent upon claim 1, incorporate the limitations of amended claim 1. Thus, Fisher does not describe, teach or suggest, expressly or inherently, all the limitations of dependent claims 2 and 3 so Applicant respectfully requests that these rejections be withdrawn and claims 2-4 be allowed.

Fisher also fails to anticipate all the elements of the new independent claims 5, 11, 15, and 19. Particularly, Fisher's disclosure of coated polyester cords to adhere the cords to rubber does not describe, teach or suggest, expressly or inherently, the limitations of the new independent claims 5, 11, 15, and 19.

Furthermore, claims 6-10, 12-14, 16-18, and 20-22, incorporate the limitations of the corresponding new independent claims. Thus, Fisher does not describe, teach or suggest, expressly or inherently, all the limitations of these dependent claims so Applicant respectfully requests that these claims be allowed.

Commissioner for Patents  
June 20, 2005  
Page 12 of 12

Serial No. 10/606,973  
Art Unit: 1771 Examiner: Ms. Arti Singh  
Atty Docket: AMG.4016.PAT

### CONCLUSION

In the present response, Applicant has amended independent claim 1 to clarify the claim and added claims 4-22. Based upon the traversals, Applicant respectfully submits that rejected claims 1-3 and new claims 4-22 are not anticipated by the cited references. Thus, Applicant believes the claims are allowable and respectfully requests that the application to advance toward issuance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at (512) 288-6635.

Based upon the addition of claims 4-21, Applicant believes that the fees for filing this amendment total \$250.00. The Office is hereby requested to charge the amount due (\$250.00) to the credit card (Form PTO-2038 attached).

No other fee is believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 50-3295 for any such required fee.

Respectfully submitted,

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By:



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